

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Roger D. Pirkey et al.

Confirmation No. 1489

Serial No.: 09/732,333

Examiner: Pyzocha, Michael J.
Art Unit: 2137

Filed: December 6, 2000

Atty Docket No. 010942-0269227
AWT-002

For: Enhanced PIN-Based Security Method and Apparatus

Submitted electronically on February 16, 2007.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the Final Office Action mailed December 21, 2006 for which a response is due March 21, 2007. No amendments are being filed with this request. This request is being filed with a Notice of Appeal under Rule 191. The review is requested for the reason(s) stated on the attached sheets. The Commissioner is authorized to charge any required fee(s) or to credit any overpayments to Pillsbury Winthrop Shaw Pittman LLP's deposit account no. 03-3975 (order no. 010942-269227). Applicants claim small entity status.

Applicants restate and incorporate herein remarks previously made in response to the pending rejections. Claims 1-2, 4-6, 9, 11-13, 16-17, 19-21, 24, 26-28, and 31-41 are pending in the application, of which claims 1, 9, 16 and 24 are independent. All pending claims stand rejected.

More particularly, independent claims 1, 9, 16 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,134,447 to Havinis et al. ("Havinis") in view of U.S. Patent No. 5,737,701 to Rosenthal et al. ("Rosenthal"). Independent claims 1, 9, 16 and 24 require, inter alia:

1. A “system-wide” list of resources to which access can be controlled without reference to a subscriber’s identity; and
2. A plurality of separate and distinct lists of resources to which access is controlled specifically in accordance with a respective subscriber’s identity.

In addition to setting forth novel and unique techniques for controlling access to resources, the claims clearly distinguish between subscribers and resources to which subscribers request access. The claims further set forth a novel apparatus and method for determining how access to different resources can be controlled for different subscribers when they request access thereto. For example, as set forth in the specification, the “system-wide” list of resources can include an “always allow” list of resources such as 911 or 0 telephone numbers. This list is consulted first, and if the resource is not on the list, a separate and distinct list of resources specific to the identity of the requesting subscriber is retrieved and consulted.

The invention set forth in the independent claims is not taught or suggested by the alleged combination of Havinis and Rosenthal.

Neither Havinis Nor Rosenthal Teaches Or Suggest Two Different Lists of Resources As Defined By The Claims

The Office Action admits that Rosenthal does not suggest two different lists. Accordingly, the Advisory Action states that “Havinis was relied on to teach the use of two lists (one system-wide and one with respect to individual subscribers)”

However, there is no meaningful difference between Havinis’s “two lists” with respect to limitations of the claims. The Office Action identifies Havinis’s “black list 392” and “gray list 394” as the alleged “two lists.” But both of these are lists of LAIN’s, or identities of subscribing LA’s. Accordingly, they are both specific to the identities of LA’s, contrary to the Examiner’s statement in the Advisory Action. More particularly, the “black list 392” contains identities of subscribing LA’s that are always denied access to location services (e.g. identities of subscribers who have not paid their bill) (col. 3, lines 47-49; col. 5, lines 4-14). The “gray list 394” contains identities of subscribing LA’s whose access to location services should be monitored. (col. 3, lines 49-51; col. 5, lines 32-44)

Clearly, both the “black list 392” and “gray list 394” contain LAIN’s, or identities of specific LA’s. More particularly, Havinis’s “two lists” are both lists of specific subscribers, and

Havinis clearly requires that the LAIN, or the identity of the requesting subscriber, be compared to the contents of both lists to determine whether service should be denied or monitored. Neither are lists of resources, much less a “system-wide” list of resources to which access may be controlled without considering the identity of the requesting subscriber, nor a distinct plurality of lists associated with specific subscribers, as required by the claims.

Havinis’s LA’s Are Subscribers, So Havinis’s “Black List” Is Not A “System-Wide List of Resources” Merely Because LA’s Are Associated With Groups of Cell Phones

Despite the undeniable fact that Havinis’s “two lists” are both lists of LAIN’s -- i.e. lists containing identities of specific subscribing LA’s -- the Advisory Action claims that they are both “system-wide” lists because “the location application ‘is associated with a group of subscribers.’”¹ This assertion is irrelevant to the limitations of the claims, which require a “system-wide list of resources” to which subscriber access is controlled without regard to the subscriber’s identity, and in any event, is contradicted by Havinis’s teachings.

As set forth in Applicants’ previous response, Havinis teaches two types of subscribers: (1) cell phone subscribers and (2) location applications (LA’s). Multiple cell phone subscribers can be associated with a given location application (LA). Havinis’s location applications (LA’s) are clearly subscribers, and not resources.

More particularly, Havinis uses the term “location application” to correspond to an organization that has a subscription for receiving location services. For example, Havinis teaches that “[w]hen a location application (LA) subscribes to location services, the wireless service provider assigns a unique Location Application Identifier Number (LAIN) to the LA. . . .” (col. 3, lines 43-46, emphasis added)

Thus, as set forth in Applicants’ previous response, Havinis’ use of the term “application” in the term “location application” (LA) is somewhat misleading. Examples of LA’s taught by Havinis include emergency centers, law enforcement agencies and fleet management companies. (col. 4, lines 30-40) Each LA has its own unique identifier LAIN (col. 3, lines 43-47). In Havinis’s system, the LA 380 (e.g. a fleet management company), and not the

¹ The Advisory Action, by admitting that both the black list and gray list “contain[] information regarding location applications,” contradicts its own assertions that Havinis teaches two different types of lists.

cell phone 300 user, subscribes to and requests location services. These requests include the LA's subscription identity (LAIN), and this subscriber identity is compared to a list (i.e. black list 392) of subscriber identities to determine whether to perform the requested location service.

Although Havinis teaches that an LA can be associated with a group of cell phone subscribers, this merely means that Havinis associates one type of subscriber (i.e. multiple cell phones) with another type of subscriber (i.e. single location application (LA)). This does not mean the black list does not contain identities of subscribers. There can simply be no question that lists 392 and 394 contain identities (i.e. LAINs) of subscribers (i.e. LA's). In fact, the Advisory Action admits that "the black lists are checked using the LAIN" (i.e. subscriber identity). Because the LAIN is clearly the identity of a subscriber (i.e. a location application) to location services, just because the black list does not contain identities of cell phones does not mean it does not contain any subscriber identities. Rather, as the Advisory Action admits, Havinis teaches that the black (and grey) list contains identities of specific subscribing location applications.

Havinis and Rosenthal Combined Do Not Suggest The Claimed Lists of Resources

The Advisory Action takes the position that because Havinis teaches "two lists" and Rosenthal teaches a "list of resources," the alleged combination of Havinis and Rosenthal "teaches the claimed limitations." However, neither Havinis nor Rosenthal teaches or suggests a "system-wide list of resources."

The Advisory Action appears to concede that Havinis's lists do not contain lists of resources. However, the Advisory Action takes the position that Havinis teaches a "system-wide" list, which combined with Rosenthal's alleged "list of resources," suggests a "system-wide list of resources."

This position is wrong in both law and fact. First, as set forth above, Havinis's black list and gray list both contain list of subscribers, not resources. More importantly, the cited prior art should be considered for what it fairly teaches, not for what words can be selectively plucked from their specifications.

Havinis clearly teaches that when a subscribing LA wants to locate one of its cell phones, it requests location services from a wireless service provider. The provider first checks the requesting LA's identity (LAIN) against its "black list" of subscribers who are barred access to

location services. Then, the provider checks the LA's identity (LAIN) against its "gray list" of subscribers whose access should be monitored. Based on these two checks of the subscribing LA's identity, access to location services are performed or denied. (see Abstract)

Meanwhile, the claims clearly require a logical progression of (e.g. in claim 1):

- [1] first comparing the resource to the system-wide list;
if the resource is included in the system-wide list:
 - providing or denying access to the resource in accordance with the system-wide list;
- if the resource is not included in the system-wide list:
 - retrieving one of the plurality of lists associated with the subscriber;
- [2] next comparing the resource to the retrieved list associated with the subscriber;

Neither Havinis nor Rosenthal, either alone or in combination, suggests the claimed invention. Rosenthal merely compares a dialed phone number against a list of phone numbers for a specific phone to determine whether a PIN is required. Havinis merely checks a subscribers' identity against a "black list" and a "gray list" to determine whether service should be blocked or monitored, respectively.

Neither Havinis nor Rosenthal teaches or suggests the claimed "system-wide" list of resources, much less the progression of checking a requested resource against the "system-wide" list, followed by checking a requested resource against a retrieved list specifically associated with the subscriber.

CONCLUSION

For at least the reasons presented above, it is respectfully submitted that the present rejections are improper. Further, the claims are believed to be in form for allowance, and such action is hereby solicited.

Respectfully submitted,
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Date: February 16, 2007



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